

Amendment in response to
January 30, 2008 final Office action

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Atty Dkt No.: 2003P02177US
Serial No.: 10/761,059

MAR 31 2008

REMARKS

Claims 1 – 46 remain in the application and stand finally rejected. Claims 1, 9, 14, 17, 32, 35, 39, 42 and 45 are amended by this proposed amendment. Although this amendment is being timely filed, the Commissioner is hereby authorized to charge any fees that may be required for this paper or credit any overpayment to Deposit Account No. 19-2179.

The “examiner should always look for enabled, allowable subject matter and communicate to applicant what that subject matter is at the earliest point possible in the prosecution of the application.” MPEP §2164.04, last paragraph (emphasis original).

Claim 4, 10, 17, 35, 40 and 42 are objected to for reciting acronyms without proper explanation. However, claim 42 specifically indicates that IM is instant messaging in line 1.

Further, dependent claims include all of the differences with the references, as the claims from which they depend. MPEP §2143.03 (“If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).”). Claims 4 and 10 depend from claim 3, which depends from claim 2, which depends from claim 1. Claim 40 depends from claim 34. Thus, while dependent claim 4 may not specify that IM is instant messaging, claim 1 does in line 1; or that SIP is Session Initiation Protocol, claim 2 does. Likewise, while dependent claims 10 and 40 may not specify that CSTA is Computer Supported Telephony Application, claims 3 and 34 do.

Claims 17 and 35 are amended to provide specific recitations for the acronyms at least responsive in part to this objection. No new matter is added. Entry of the amendment, reconsideration and withdrawal of the objection to claims 4, 10, 17, 35, 40 and 42 is respectfully requested.

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Claim 17 is finally rejected under 35 U.S.C. §101 for reciting converting a CSTA device to a SIP device. Responsive thereto, claim 17 (and corresponding recitations in claim 45) is/are amended to recite that “messages from said CSTA device to messages for a SIP device” as described by the specification at page 7, lines 12 – 14, for example. No new matter is added and this is neither shown nor suggested by any reference of record. As this amendment to claim 17 overcomes the final rejection of claim 17 under 35 U.S.C. §101, entry of the amendment is in order. Reconsideration and withdrawal of the final rejection of claim 17 under 35 U.S.C. §101 is respectfully requested.

Claims 1 – 22, 24 and 28 – 46 are finally rejected as being unpatentable under 35 U.S.C. §103(a) over U.S. Patent Application number 2004/0205209 to Wengrovitz et al. in view of U.S. Patent Application number 2005/0013421 to Chavez et al. Claim 23 is finally rejected as being unpatentable under 35 U.S.C. §103(a) over Wengrovitz et al. and Chavez et al. in view of U.S. Patent Application number 2005/0059418 to Northcutt. Claim 25 is finally rejected as being unpatentable under 35 U.S.C. §103(a) over Wengrovitz et al. and Chavez et al. in view of D.E. Patent number DE10127360 to Jerbi et al. Claims 26 and 27 are finally rejected as being unpatentable under 35 U.S.C. §103(a) over Wengrovitz et al. and Chavez et al. in view of U.S. Patent Application number 2005/0108348 to Lee.

Applicants note that Wengrovitz et al., Chavez et al., Northcutt and Lee all published subsequent to the filing date of the present application. If necessary, the applicants may offer evidence of invention prior to one of more of these references being applied as references under 35 U.S.C. §103(a) through 35 U.S.C. §102(e). However, for reasons set forth below, such a showing is not believed necessary.

Regarding finally rejected claims 9 (and 39), the final Office action (Final) acknowledges that “Wengrovitz does not explicitly teach: full IM capability includes composing messages, responding to messages and **creating a buddy list.**” #28, page 7 (emphasis added). So, the Final asserts that “Chavez teaches, (Fig. 7, ¶0035, lines 9-11) **using a phone to compose and display instant messages using its key buttons and display (¶0022, lines 1-17) full IM**

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capability." #29, page 9 (emphasis original). However, composing and displaying instant messages is not full IM capability and does not include "**creating a buddy list.**" *Supra.*

Chavez teaches that "[t]he destination address can be inputted by the user, derived from the source address of a received electronic text message to which the formed electronic message is responsive, and/or selected from the user among a predetermined set of destination addresses." Paragraph 0022, lines 14 – 17.

Selecting a destination address for a text message from a "predetermined set of destination addresses" is not the same as creating and, implicitly ("full IM capability"), using a buddy list as recited by finally rejected claims 1 and 9. One may maintain list a number of e-mail addresses in Outlook contacts, for example. Just because one can look up and use those listed contacts, does not make the listed contacts a buddy list. A buddy list has a common, well-known meaning in the art that is also well-known to the layman as well. "A Buddy List is a window that shows all your buddies (friends, family, coworkers, and others) who are signed on" http://en.wikipedia.org/wiki/Buddy_List. "a **buddy list** is a listing of family and friends in a software program such as an Instant Messenger. These lists enable users to keep track of all their friends and almost always will allow users to see what buddies are currently logged in or available to chat." <http://www.computerhope.com/jargon/b/buddylis.htm> (emphasis original).

So, while Chavez may teach "using a phone to compose and display instant messages" as the Final asserts, and selecting a destination address from a "predetermined set of destination addresses," Chavez fails to teach providing full IM capability to a digital telephone as recited by finally rejected claims 1, 14, 32, and 42, much less creating a buddy list as recited by finally rejected claims 9 and 39.

Be that as it may, claims 1, 14, 32 and 42 are amended herein to recite that "full IM capability [includes] creating a buddy list." This is supported by finally rejected claims 9 and 39. No new matter is added and this is neither shown or suggested by any reference of record.

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Further, claims 9 and 39 are amended to recite that "full IM capability includes further includes composing messages, retrieving and responding to messages." This is inherent in full IM capability (also has a well known and not shown) and is also supported in the specification, e.g., at page 6, lines 28 – 29 ("IM management for digital telephones includes for example, allowing the telephone user to compose, retrieve and respond to a message."). No new matter is added and this is neither shown or suggested by any reference of record. Therefore, Chavez et al. fails to teach providing full IM capability as recited in claims 1, 9, 14, 32, 39 and 42, as rejected and as amended. The combination of Wengrovitz et al. with Chavez et al. fails to result in the present invention as recited in claims 1, 9, 14, 32, 39 and 42, as rejected and as amended.

Further, as noted hereinabove, because dependent claims include all of the recitations as the claims from which they depend, the combination of Wengrovitz et al. with Chavez et al. fails to result in the present invention as recited in dependent claims 2 – 8, 10 – 13, 15 – 22, 24, 28 – 31, 33 – 38, 40, 41 and 43 – 46, which depend from claims 1, 14, 32 and 42. Entry of the amendment, reconsideration and withdrawal of the final rejection of claims 1 – 22, 24 and 28 – 46 under 35 U.S.C. §103(a) is respectfully requested.

Regarding the final rejection of claims 23, 25, 26 and 27, none of Northcutt, Jerbi et al. or Lee, teaches providing full IM capability that includes creating a buddy list as recited by claim 14, from which claims 23, 25, 26 and 27 depend. Therefore, combining Wengrovitz et al. with Northcutt, Jerbi et al. or Lee fails to result in the present invention as recited in claims 23, 25, 26 and 27. Entry of the amendment, reconsideration and withdrawal of the final rejection of claims 23, 25, 26 and 27, under 35 U.S.C. §103(a) is respectfully requested.

The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance, both for the amendment to the claims and for the reasons set forth above, the applicants respectfully request entry of the amendment, reconsideration and withdrawal of the objection to the claims, reconsideration and withdrawal of final the rejection of claims 1 – 46 under 35 U.S.C. §§101 and 103(a) and allowance of the application to issue.

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Applicants have previously noted that MPEP §706 "Rejection of Claims," subsection III, "PATENTABLE SUBJECT MATTER DISCLOSED BUT NOT CLAIMED" provides in pertinent part that

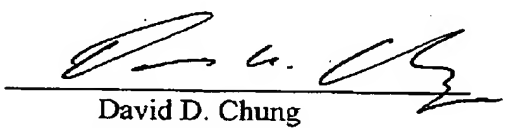
If the examiner is satisfied after the search has been completed that patentable subject matter has been disclosed and the record indicates that the applicant intends to claim such subject matter, he or she may note in the Office action that **certain aspects or features** of the patentable invention have not been claimed and that if properly claimed such claims **may be given favorable consideration**.

(emphasis added). The applicants believe that the written description of the present application is quite different than, and not suggested by, any reference of record. Accordingly, should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the telephone number listed below for a telephonic or personal interview to discuss any other changes.

Respectfully submitted,

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(Date)

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